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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BERND SUNDERMANN ET AL

Serial No.: 10/071,229 Group Art Unit: 1626

Filed: FEBRUARY 11, 2002 Examiner: Kamal Saeed

Title: SUBSTITUTED 2-DIALKYLAMINOALKYLBIPHENYL  
DERIVATIVES

REPLY TO OFFICE ACTION

Commissioner for Patents  
Washington, D.C. 20231

Sir:

This reply is accompanied by a Petition under 37 C.F.R. §1.136(a) for a one-month extension of time, and by a check in the amount of \$110.00 in payment of the required extension fee.

Responsive to the Office Action mailed August 26, 2002 in the above-captioned application, applicants hereby provisionally elect the claims of Group I, namely claims 1-7 and 22, for examination in the instant application in the event the restriction requirement is not withdrawn. This election is made with partial traverse.

Insofar as the restriction requirement seeks to require method of use claim 23 to be restricted away from compound and composition claims 1-7 and 22, it is respectfully traversed because the reasons given to justify the restriction are erroneous. Restriction is assertedly justified because "in the instant case, the product, as demonstrated in pages 1 and 2 of the specification, can be used for example treating depression, constipation etc." Thus restriction is attempted to be justified because the product allegedly could be used for uses other than the method of claim 23. However, applicants wish to point out that the treatment of depression is not a use other than the use of claim 23. On the contrary, depressions are explicitly listed among the conditions to be treated in claim 23.

Thus, the suitability of the claimed compounds for treating depression is no evidence of suitability for a use other than the use of claim 23.

With respect to the alleged utility to treat constipation, the assertion in the Office Action is clearly in error. Pages 1 and 2 of the specification do not demonstrate that the product is suitable to treat constipation. On the contrary, pages 1 and 2 discuss the fact that constipation is a known undesirable side effect of conventional opioids and that it is an object of the invention to provide substances which have as few as possible of the side effects of opioid analgesics, such as constipation. This in no way establishes that the compounds of the present invention can be used to treat constipation.

Thus, the reasons given for requiring restriction of claim 23 away from the claims of Group I do not establish a proper basis for restriction, and reconsideration and withdrawal of the restriction are respectfully requested.

With regard to the requirement for election of species, applicants hereby elect the species (3'-methoxybiphenyl-2-ylmethyl)dimethylamine and its corresponding hydrochloride salt. Claims 1, 4, 5, 7, 22 and 23 are deemed to read on the elected species.

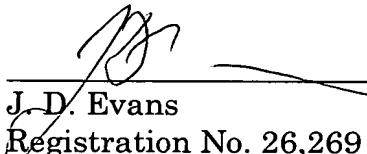
Favorable action on the application is earnestly solicited.

If there are any questions regarding this reply or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #148/50899).

Respectfully submitted,

October 1, 2002

  
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